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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91194358
Party	Defendant Jeffrey Pancer
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Without rehashing the history of the motion to compel, the purpose of this supplemental brief is to provide guidance to the Interlocutory Attorney as to the meaning and application of the "normal course of business" as the term pertains to the production of documents. When documents are produced in response to document requests propounded under Fed.R.Civ.P. 34(b) and TBMP Rule 406, the responding party may, in its discretion, produce them as they are kept in the usual course of business or organize and label them to correspond with the individual document requests. In the case at hand, Opposer produced 300 unlabeled, unnumbered, and randomly compiled documents and failed to identify how they correspond to the appropriate document requests. Opposer purports that this was appropriate because it reflects how the documents were kept in

Opposer's ordinary and normal course of business. Opposer's counsel stated during the teleconference that he provided the documents to Applicant's counsel in the exact manner in which he received the documents from Opposer –and that Opposer went through his files, culled the documents that were responsive to the requests and sent them to his counsel. Applicant maintains that the production was and remains wholly devoid of organizational structure and could not possibly reflect how the documents were kept in Opposer's normal course of business. Moreover, even if Opposer was so disorganized as to keep documents in this manner, Opposer should not be permitted to produce documents in the manner it has. Resolution of the motion has been put on hold until the Interlocutory Attorney has had a chance to review this supplemental brief to get a better understanding what it means under the law to produce documents in the usual course of business.

II. Argument.

At the outset of this argument, Applicant notes as the courts do that "[Rule 34(b)] does not explain what it means by the term 'usual course of business.'" See *Cardenas v. Dorel Juvenile Group, Inc.*, 230 F.R.D. 611, 618 (D. Kan. 2005). Accordingly, it has been left for the district courts to decide through case law. District Courts across the country have taken a very practical view toward this standard as recently set forth by the United States District Court for the Northern District of New York in *Pass & Seymour, Inc. v. Hubbell, Inc.*:

The most obvious means of complying with the requirement of *Rule 34(b)* to produce documents as they are kept in the usual course of business is to permit the requesting party to inspect the documents where they are maintained, and in the manner in which they are organized by the producing party. It logically follows that when production occurs by means other than permitting the demanding party access to the original records as they are organized and maintained by the responding party, such as by instead choosing to copy the documents and produce the duplicates, they

must be organized in such a way that the system utilized by the producing party is replicated; in other words, the documents should be produced, organized and labeled and, if appropriate, indexed just as they are maintained by the producing party.

See, *Pass & Seymour*, 255 F.R.D. 331, 2008 WL 4240490 *citing*, *Johnson v. Kraft Foods North America, Inc.*, 236 F.R.D. 535, 540-541 (D. Kan. 2006).

Here, Opposer has attempted to serve its documents on Applicant in a random and unorganized manner and then maintain that it did so under its ordinary course of business so that it could avoid indexing, numbering and identifying which documents corresponded to which specific requests. Opposer's counsel admitted in the teleconference that the documents were culled from folders by Opposer and then given to counsel.¹ By so doing, Opposer certainly did not provide documents in the usual course of business under the plain meaning of the rule. Of course, even without that admission, Opposer may not simply dump documents on Applicant and claim that they were provided in the usual course of business. As held in *Synventive Molding Solutions, Inc., Plaintiff, v. Husky Injection Molding Systems, Inc.*, 262 F.R.D. 365, 2009 U.S. Dist. LEXIS 105306 (D.Vt. 2009) production under the "ordinary course of business" is only permissible provided certain additional information and guidance is provided:

In order to produce documents as they are maintained in the ordinary course of business, the producing party must, at a minimum, "provide information about each document which...would include...the identity of the custodian or person from whom the documents were obtained, an indication of whether they are retained in hard copy or digital format, assurance that the documents have been produced in the order in which they are maintained, and a general description of the filing system from which they were recovered.

¹ This admission should have led the Interlocutory Attorney to rule in favor of Applicant on this part of the motion to compel without any further briefing. "Documents removed from their original folders and copied are deemed not produced in the manner in which the originals were ordinarily kept." See *United States v. O'Keefe*, 537 F. Supp. 2d 14, 19 (D.D.C. 2008) (applying *Rule 34(b)* by analogy in a criminal setting).

Synventive, 262 F.R.D. at 371, 2009. The *Synventive* Court goes on to emphasize that the production response, like Opposer's production response in this Opposition, was completely devoid of any organizational structure and as a result the party producing the documents was ordered to amend its production response. Here, Opposer has not provided the requisite information nor could the Opposer truthfully state that the documents produced were done so in the order in which they were maintained.

Further, the *Pass & Seymour* Court goes on to say that:

It should be noted that if the system utilized by the producing party to organize and maintain the documents is so deficient as to undermine the usefulness of production under this portion of the rule, the obligations imposed under *Rule 34* may not have been met even where this procedure is followed. See *Kozlowski v. Sears, Roebuck & Co.*, 73 F.R.D. 73, 76 (D. Mass. 1976) (a party "may not excuse itself from compliance of *Rule 34* . . . by utilizing a system of record-keeping which conceals rather than discloses relevant records, or makes it unduly difficult to identify or locate them...).

Pass & Seymour, 262 F.R.D. at 336.

While the majority of cases that require analysis of production of documents in the ordinary course of business involve the production of thousands of documents², the mandates of Fed.R.Civ.P. 34(b) do not apply solely to situations when an unusually large number of documents are produced. See e.g., *T.N. Taube Corp. v. Marine Midland Mortgage Corp.*, 136 F.R.D. 449, 456 (W.D.N.C. 1991) wherein the Court held that a response to a production request that contained 789 documents provided in a box with no discernable order, the court expressed doubt that production was made as the documents were kept in the usual course of business, and thus directed that the documents be

² For instance, the only TTAB decision dealing with the specific issue of sufficiency of production in connection with the usual course of business involved the entry of Discovery sanctions against a party that failed to properly index its discovery production *Amazon Technologies, Inc. v. Jeffrey S. Wax*, 95 USPQ2d 1865 (TTAB 2010)

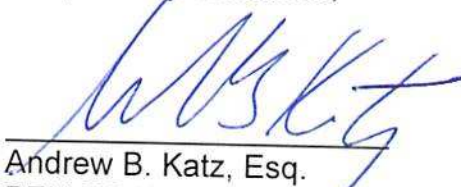
organized and labeled to indicate the specific document demand to which each related. The fact that Opposer's total production is only 300 pages should not relieve him of the responsibility of organizing and labeling the documents—in fact, if anything, it presents less of a burden to engage in such labeling in this circumstance than it does on a party that produces thousands of documents. Finally, it should not be lost on the Interlocutory Attorney that Opposer has also stated in its brief in opposition to this motion that Opposer has files that span many years and that they are organized according to categories. The fact that this organization was completely dropped from the response to the document requests exhibits an utter disregard for the rules.

III. Conclusion

In light of the case law setting forth the requirements for production of documents in the usual course of business, it is clear that Opposer failed to meet these requirements. Accordingly, Opposer should be ordered to label and index the produced documents and identify which document request they correspond to.

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Respectfully submitted,



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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of Applicant's Supplemental Brief in Support of Its Motion to Compel was served by email and First Class Mail, postage prepaid, on this 1st day of July 2011 on the following:

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